REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

I. Status of the claims

Claims 1-3 are withdrawn.

Claims 1-26 are currently pending in this application.

II. Claim rejection – 35 U.S.C. § 102(b)

Claims 4-8, 14-15 and 24-26 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,618,261 (hereinafter Nevyas). The Office Action asserts that "Nevyas discloses in figures 1-2B an eye protosing [sic] speculum that anticipates a device for treatment of degenerative retinal disease," and states that that the Nevyas device includes a moving member "configured for chronic contact with at least a portion of the eye" and configured for "contact with the retina of the eye and implantation in a subretinal space of the eye." (Office Action at page 2). Applicants respectfully traverse this ground for rejection: the Nevyas device is completely unrelated to the device claimed in the present application.

"To anticipate a claim, the reference must teach each element of the claim," and "the identical invention must be shown in as complete detail as is contained in the … claim." (*See* MPEP § 2131, citation omitted). Furthermore, because the limitations of each independent claim are incorporated into claims depending therefrom (*see e.g.*, 35 U.S.C. § 112), if an independent claim is not anticipated, the dependent claims are not anticipated. In the present application, claims 4 and 24 are independent; claims 5-8, 14-15 and 25-26 are dependent.

A. Independent claims

Nevyas discloses a proptosing speculum for use in eye surgery. In use, the speculum holds back the upper and lower eyelids pushing the eyeball outward, exposing more surface and allowing greater access to the eyeball.

The present application relates to an implantable device useful for the treatment of degenerative retinal disease. (*See e.g.*, U.S. Publication No. 2005/0033202 at abstract). For example, independent claims 4 and 24 of the present application relate to a "device for treatment of a degenerative retinal disease" which includes "a moving member" or a "moving means" in chronic contact with at least a portion of the eye. The device of Nevyas does not anticipate the device of the present claims; in fact, the Nevyas device is completely unrelated to the devices described in the present application.

First, the implantable device of the present application is useful for the treatment of degenerative retinal disease. (*See e.g.*, U.S. Publication No. 2005/0033202 at abstract). In contrast, Nevyas describes a speculum for holding back the upper and lower eyelids, and proptosing the eyeball of a patient during eye surgery. (*See e.g.*, Nevyas at abstract). Thus, the Nevyas device is not itself useful for the treatment *any* disease (*e.g.*, degenerative retinal disease), it is simply a surgical tool.

Second, the implantable device of the present application includes a moving member configured for chronic contact with at least a portion of the eye, *e.g.*, the device of the present application "may be configured for [chronic] contact with a retina of the eye, preferably positioned in a subretinal space." *(See e.g.*, U.S. Publication No. 2005/0033202 at abstract). Indeed, the present specification provides support for chronic contact on the order of years (*see e.g.*, paragraph [0052] of U.S. Publication No. 2005/0033202). In contrast, the surgical tool described by Nevyas is designed for only temporary contact with the eyelid and outermost portions of the eyeball (*e.g.*, retrobulbar orbital contents, including eye muscles, fatty deposits and possibly the sclera (*see* Nevyas at col. 3, lines 14-17; Figures 2a and 2b) during surgery. In

particular, the Nevyas speculum is designed to retract the eyelids and to expose the eyeball to facilitate access to the eye by a surgeon. Such contact, if chronic, could not possibly be beneficial to the patient. Note also, that the present application specifically states that the eyelid is not considered to be part of the eye. (*See* U.S. Publication No. 2005/0033202 at paragraph [0038]).

Accordingly, Nevyas does not anticipate independent claims 4 and 24, and as such, Nevyas does not anticipate the dependent claims 5-8, 14-15 and 25-26.

B. Dependent claims – additional arguments

In addition, the Nevyas device ***is not*** configured to contact the retina or the subretinal space as recited in dependent claims 6, 7, 25 and 26, nor does Nevyas disclose or suggest – in any manner, for any purpose – contact with a retina or implantation of the Nevyas device in the subretinal space. Rather, Nevyas discloses contact with eyelids and retrobulbar orbital contents, including eye muscles, fatty deposits and possibly the sclera (*see* Nevyas at col. 3, lines 14-17; Figures 2a and 2b), temporarily, during a surgical procedure.

Accordingly, for at least the reasons describe above, Nevyas does not anticipate claims 4-8, 14-15 and 24-26 of the present application, and reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

III. Claim rejection – 35 U.S.C. § 103

Claims 16-20 and 22-23 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Nevyas. Specifically, the Office Action asserts that while Nevyas discloses "a device for treating degenerative retinal diseases, substantially as claimed," Nevyas does not disclose "the actuator comprising an electrical source of the movement member comprising an electrostatically activated member, a piezoelectric member or an electractive polymer member or the heating element coupled to an electrical source." (Office Action at page 3). Nevertheless, the Office Action asserts that it would have been obvious to apply an electric source to the device of

Nevyas, because the Nevyas device "appears to be made of an metallic material which makes it an electrical source (a metallic material is a conductor of electrical current)." (Office Action at page 3). The Office Action continues, asserting that the composition of the moving member is merely a design choice, requires no inventive step, and posses no novelty. (Office Action at page 3). Applicants respectfully traverse the rejection.

First, as described in section II, Nevyas does not disclose "a device for treating degenerative retinal diseases, substantially as claimed." Nevyas discloses a surgical tool, comparable to a specialized forceps; the present application discloses and claims an implantable device useful for treatment of degenerative retinal disease and configured for chronic contact with at least a portion of the eye. One skilled in the art would be hard pressed to understand what, exactly, the two devices actually have in common.

Second, the mere fact that the surgical tool described in Nevyas is made from metal has no bearing or correlation to its suitability either to act as, or to incorporate an electrical source. In fact, applying an electrical source to the Nevyas device makes no sense whatsoever. The surgical tool of Neyvas is to be held by a surgeon, and is to be applied to the eyeball for use during surgery. It is completely unclear as to where electric current should be applied and for what purpose.

In summary, Nevyas neither discloses, suggests or teaches the use of an implantable device useful for treating degenerative retinal diseases configured for chronic contact with at least a portion of the eye. Additionally, Nevyas does not disclose, suggest or teach the use of an electrical source with the Nevyas speculum, nor would the application of an electrical source with the Nevyas speculum be obvious to one skilled in the art. In fact, the Nevyas device would most likely be non-functional if any part of the device were electrified. Given the huge disparity between the Nevyas device and the claimed device, it is unclear how one skilled in the art would find anything regarding one device obvious in light of the other.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

IV. Allowable subject matter

The Office Action objected to claims 9-13 and 21 because they are allegedly dependent on rejected base claims, but would be allowable if rewritten in independent form. (Office Action at page 4). Applicants respectfully contend that independent claim 4 and all of its dependents (including claims 9-13 and 21) are allowable for at least the reasons stated above in sections II and III. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

V. Conclusion

The present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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